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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,684	02/11/2002	John Hulls	033357-008	9166
21839	7590	11/12/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			KATCHEVES, BASIL S	
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3635

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,684

Applicant(s)HULLS ET AL. **Examiner**

Basil Katcheves

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 22-135 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 and 64-135 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-18, group I, drawn to a force resisting device with active element, classified in class 52.
- II. Claims 22-63, group II, drawn to a force resisting device with non planar element, classified in class 52.
- III. Claims 64-77 and 115-125, group III, drawn to a shear membrane, classified in class 52.
- IV. Claims 78-100, group IV, drawn to a three plane force resisting device, classified in class 52.
- V. Claims 101-113 and 126-135, group V, drawn to a shear panel, classified in class 52.

The inventions are distinct, each from the other because of the following reasons:

Inventions group I and group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions an active element of group I may be used in any portion of a framed wall for any purpose.

Inventions group I and group III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP §

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808.01). In the instant case the different inventions an active element of group I may be used in any portion of a framed wall for any purpose.

Inventions group I and group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions an active element of group I may be used in any portion of a framed wall for any purpose.

Inventions group I and group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions an active element of group I may be used in any portion of a framed wall for any purpose.

Inventions group II and group III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention group II has separate utility such as use inside a building frame. See MPEP § 806.05(d).

Inventions group II and group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions group IV contains three distinct planes, while group II is simply non planar.

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Inventions group II and group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions group V is a shear panel.

Inventions group III and group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions group III is a shear membrane.

Inventions group III and group IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions group III is a shear membrane.

Inventions group IV and group V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions group V is a shear panel.

Because these inventions are distinct for the reasons given above and the search required for the groups differs therefore, restriction for examination purposes as indicated is proper.

A telephone call was made to Jeff Killian on 11/4/04 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31 and 59 recite the limitation "the v-shape" in line 1. There is insufficient antecedent basis for this limitation in these claims.

Claim 33 recites the limitation "the first dimension" inline 6. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,761,001 to Mueller.

Regarding claim 22, Mueller discloses a force resisting device having an active element (fig. 14: 100) with a non planar region (fig. 10: 970). Mueller does not specifically disclose two elastic and one plastic regions. Mueller discloses the basic

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claim structure of the instant application but does not disclose specific material properties. Applicant fails to show criticality for specifically claimed properties, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims as Mueller uses springs and plates, having elastic and non elastic characteristics.

Regarding claim 23, Mueller discloses the basic claim structure of the instant application but does not disclose specific forces. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use these specified forces on the device, as these forces are commonly exerted during earthquakes.

Regarding claim 24, Mueller discloses the capability to attain an elastic, plastic and elastic properties (fig. 8: see spring and sheet unit).

Regarding claim 25, Mueller does not specifically disclose the force as going from a maximum positive to a neutral force. It would have been obvious to one having ordinary skill in the art at the time the invention was made to that this force property would occur with Mueller, as when an earthquake ceases, the forces move toward neutral.

Regarding claim 26, Mueller discloses the capability to attain an elastic, plastic and elastic properties (fig. 8: see spring and sheet unit).

Regarding claim 27, Mueller does not specifically disclose the force as going from a maximum positive to a neutral force. It would have been obvious to one having ordinary skill in the art at the time the invention was made to that this force property

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would occur with Mueller, as when an earthquake ceases, the forces move toward neutral.

Regarding claim 28, Mueller discloses the capability to attain an elastic, plastic and elastic properties (fig. 8: see spring and sheet unit).

Regarding claim 29, Mueller does not specifically disclose elastic and plastic regions during decreasing forces, however, it would have been obvious at the time of the invention to have the device go through a plastic region and to an elastic region (fig. 8: see spring) while forces decrease.

Regarding claim 30, Mueller discloses the non planar region (fig. 8: assembly) as having a V shape (fig. 8: see V shape between 961 and 962 on left and right sides) when viewed from a perpendicular direction from the plane.

Regarding claim 31, Mueller discloses the V shape to be non symmetrical.

Regarding claim 32, Mueller discloses the member as being for a shear force (title).

Regarding claim 33, Mueller discloses the shear member as being planar between two studs (fig. 1A: 100), the non planar portion (fig. 8: assembly) being located between the two side portions.

Regarding claim 34, Mueller discloses the non planar region (fig. 8: assembly) as having a V shape (fig. 8: see V shape between 961 and 962 on left and right sides) when viewed from a perpendicular direction from the plane.

Regarding claim 35, Mueller discloses the V shape to be non symmetrical.

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Regarding claim 36, Mueller discloses two studs (fig. 24: 1900) located adjacent to the member.

Regarding claim 37, Mueller discloses two studs, a frame and an opening in the frame (fig. 24A).

Regarding claim 38, Mueller discloses a frame (fig. 24A) around an opening and a shear membrane (fig. 24A: 1806).

Regarding claim 39, Mueller discloses the use of plywood for shear panel construction (column 2, line 15).

Regarding claim 40, Mueller discloses a means for attaching the shear panel to an adjacent building structure (fig. 1B: 130).

Regarding claim 41, Mueller discloses the adjacent building structure as being a foundation (abstract).

Regarding claim 42, Mueller discloses the connection between the panel and foundation as a means of transmitting forces (fig. 1B: see embedded section 130).

Regarding claim 43, Mueller discloses a force resisting device having an active element (fig. 14: 100) with a non planar region (fig. 10: 970). Mueller does not specifically disclose two elastic and one plastic regions. Mueller discloses the basic claim structure of the instant application but does not disclose specific material properties. Applicant fails to show criticality for specifically claimed properties, therefore it would have been an obvious design choice to use the dimensions such as specified in these claims as Mueller uses springs and plates, having elastic and non elastic

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characteristics. Mueller also discloses the panel as fixed between two studs (fig. 24A: 1900).

Regarding claim 44, Mueller discloses the non planar region (fig. 8: assembly) as having a V shape (fig. 8: see V shape between 961 and 962 on left and right sides) when viewed from a perpendicular direction from the plane.

Regarding claim 45, Mueller discloses the V shape to be non symmetrical.

Regarding claim 46, Mueller discloses two studs, a frame and an opening in the frame (fig. 24A). Mueller also discloses the use of wood for the structure (column 1, line 21).

Regarding claim 47, Mueller discloses two studs, a frame and an opening in the frame (fig. 24A).

Regarding claim 48, Mueller discloses the openings in the frame (fig. 24A) as being sized to adequately hold a window.

Regarding claim 49, Mueller discloses a frame (fig. 24A) around an opening and a shear membrane (fig. 24A: 1806).

Regarding claim 50, Mueller discloses the use of plywood for shear panel construction (column 2, line 15).

Regarding claim 51, Mueller does not specifically disclose the force acting upon the member as going from a neutral to a maximum positive force. However, it would have been obvious to design the shear panel to accept neutral to maximum forces in order to resist natural forces such as earthquakes, as a shear panel is intended to resist such forces.

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Regarding claim 52, Mueller discloses the capability to attain an elastic, plastic and elastic properties (fig. 8: see spring and sheet unit).

Regarding claim 53, Mueller does not specifically disclose the force as going from a maximum positive to a neutral force. It would have been obvious to one having ordinary skill in the art at the time the invention was made to that this force property would occur with Mueller, as when an earthquake ceases, the forces move toward neutral.

Regarding claim 54, Mueller discloses the capability to attain an elastic, plastic and elastic properties (fig. 8: see spring and sheet unit).

Regarding claim 55, Mueller does not specifically disclose the force as going from a maximum positive to a neutral force. It would have been obvious to one having ordinary skill in the art at the time the invention was made to that this force property would occur with Mueller, as when an earthquake ceases, the forces move toward neutral.

Regarding claim 56, Mueller discloses the capability to attain an elastic, plastic and elastic properties (fig. 8: see spring and sheet unit).

Regarding claim 57, Mueller does not specifically disclose elastic and plastic regions during decreasing forces, however, it would have been obvious at the time of the invention to have the device go through a plastic region and to an elastic region (fig. 8: see spring) while forces decrease.

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Regarding claim 58, Mueller discloses the non planar region (fig. 8: assembly) as having a V shape (fig. 8: see V shape between 961 and 962 on left and right sides) when viewed from a perpendicular direction from the plane.

Regarding claim 59, Mueller discloses the V shape to be non symmetrical.

Regarding claim 60, Mueller discloses the member as being for a shear force (title).

Regarding claim 61, Mueller discloses a means for attaching the shear panel to an adjacent building structure (fig. 1B: 130).

Regarding claim 62, Mueller discloses the adjacent building structure as being a foundation (abstract).

Regarding claim 63, Mueller discloses the use of shear panels in buildings (column 1, lines 18-19).

Response to Arguments

Applicant's arguments filed 9/7/04 have been fully considered but are moot under new grounds of rejections.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited patents listed on the included form PTO-892 further show the state of the art with respect to shear panels in general.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (703) 306-0232. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman, can be reached at (703) 308-0832.

BK


Basil Katcheves

11/09/04

Examiner AU 3635